

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/071,490

First Named Inventor: J.A. Marchosky

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Title: Compositions and Methods for Forming
and Strengthening Bone

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Commissioner for Patents
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REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52

Appellant herein requests a rehearing regarding the decision by the Board of Patent Appeals and Interferences dated January 23, 2009.

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Remarks

Appellant herein requests a rehearing regarding the Decision by the Board of Patent Appeals and Interferences ("the Board") mailed on January 23, 2009 in view of Appellant's Appeal filed August 17, 2007.

An Appellant may file a single request for rehearing within two months of the date of an original Decision of the Board. 37 C.F.R. § 41.52(a)(1). A request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. *Id.* Accordingly, rehearing is sought on the grounds that the Board overlooked Appellant's arguments set forth in the Appeal, and because the Board raised new grounds for rejection.

I. The Board overlooked statements of standards for Written Description under 35 U.S.C. §112 put forth by Appellant.

In the Appeal, Appellant stated that

To comply with the written description requirement, "the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question." *Fujikawa v. Wattanasin*, 93 F.3d 1559 (Fed. Cir. 1996) at p. 1570. Finding the same wording (*ipsis verbis*) used in the claim is not necessary. *Id.* Thus, so long as a person "of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met." *In re Alton*, 76 F.3d 1168 (Fed. Cir. 1996) at p. 1175. "... [H]ow the specification accomplishes this is not material." *Id.* At p. 1172 (citing *In re Wertheim*, 541 F.2d 257, 262 (C.C.P.A. 1976)."¹

Appellant further demonstrated that the specification provided written description for the claimed subject matter, whether or not the text of claim 104 could be found in the written description *ipsis verbis*. For example, Appellant stated that

Claim 104 adds to this three-component composition, but one feature - non-decalcified bone matrix (defined on page 9, lines 3-5 and page 16, lines 3-8 of originally filed specification]). Yet the use of the combination of NBM and DBM, as an alternative DBM alone as a constituent of disclosed compositions

¹ Appeal page 17

for its osteoinductive advantages is expressly provided for on page 16, lines 5-8, of the specification as originally filed.²

However, in the Decision, the Board stated that “There is no word-for-word description of a composition consisting essentially of : 1) HA, 2) CB, 3) DBM, and 4) NBM as required by claim 104.”³

Because there is no requirement for a word-for-word description of any claim, the Board based its decision on an erroneous standard, and Appellant therefore respectfully requests a Rehearing of the Appeal.

II. The Board raised new grounds for rejection.

An Appellant may file a Request for Rehearing when the Board states a new ground of rejection. 37 C.F.R. §41.52(a)(3). In this case, the Board raises for the first time an artificial distinction between a three- and four-component composition in finding inadequate support in the specification for claim 104.⁴

In the Decision, the Board asserts that “In addition to DBM, NBM, HA, the composition (FF2) can comprise CB (Spec. 4:12) and growth factors (id. at 4:1-9).⁵ However, as set forth in the specification, components of compositions of the invention can display several properties, including:

a source of an angiogenesis-stimulating agent, a source of an osteoinductive agent, an osteoconductive scaffolding component, a substance for allowing easy flow and volumetric conformation and for holding the angiogenesis-stimulating agent and osteoinductive agent and allowing the slow release of these components, and a substance for preventing the composition from moving away from the location where placed.⁶

The specification further states that “some materials which may be used in the compositions of the present invention may serve as more than one of the above components.”⁷ Thus, although the Board appears to regard the specification as providing support for only a three-component composition having only HA, CB and DBM but does

² Appeal page 18

³ Decision, page 6

⁴ Decision, page 7 lines 9-10 and 13-15

⁵ Decision, page 5 lines 10-11

⁶ Specification as filed, page 12 lines 7-14

not support a four-component composition, the Board's position, the Board's own findings of fact describe compositions that can include four components, wherein the specification indicates that two functions can be provided by one component.

The Board, therefore, presents reasons for rejection not found prior to the present Decision.

Conclusion

For the above-stated reasons, Appellant requests rehearing of the Decision of January 23, 2009. Because this Response is submitted within two months of the mail date of the Decision, Appellant believes that there is no fee due. However, if the PTO determines that a payment is due, the Commissioner is hereby authorized to credit any overpayment or to charge any deficiency in connection with this application to Deposit Account 19-3140.

Dated: March 23, 2009

Respectfully submitted,

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(..continued)

Id. page 12 lines 14-16